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Mailed:
July 25, 2006
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Congoleum Corporation

Serial No. 78239930

Anthony F. Lo Cicero of Amster Rothstein & Ebenstein LLP
for Congoleum Corporation.

Idi Aisha Clark, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Hohein, Bucher and Walsh, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Congoleum Corporation, seeks registration on the
Principal Register of the mark **PACESETTER** (*in standard
character form*) for goods identified in the application as
follows:

"plastic floor covering having a water
resistant, smooth or embossed surface in
rolls or tiles" in International Class 27.¹

¹ Application Serial No. 78239930 was filed on April 21, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. An amendment to allege use (AAU) was filed on July 15, 2003, alleging first use anywhere and first use in commerce at least as early as June 10, 2003.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register applicant's mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the mark shown below:



which is registered for

"home improvement products - namely, aluminum storm windows and doors, replacement prime windows, windows, doors, patio covers, and porch and patio enclosures" in International Class 6,² and

"installation of storm windows and doors, replacement prime windows, windows, doors, awnings, patio covers, and porch and patio enclosures" in International Class 37,³

² Registration No. 1136007 issued on May 27, 1980, having claims of first use anywhere and first use in commerce at least as early as July 14, 1978; Section 8 affidavit accepted (six-year) and Section 15 affidavit acknowledged; renewed.

³ Registration No. 1146284 issued on January 20, 1981, having claims of first use anywhere and first use in commerce at least as early as July 14, 1978; Section 8 affidavit accepted (six-year) and Section 15 affidavit acknowledged; renewed.

as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed this appeal, but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant argues that confusion is not likely due to differences in the sight, sound and meaning of the respective marks, as well as differences between its goods and the cited goods and services. By contrast, the Trademark Examining Attorney contends that applicant's mark is identical to the dominant term in registrant's mark, that applicant's goods are related to registrant's goods and services, and that they are available within the same channels of trade.

Preliminary matter

Attached to the initial Office action was a copy from the United States Patent and Trademark Office (USPTO) records of a then-pending application for the mark

PACESETTER WEATHERMASTER EXTERIOR WALL SYSTEM, also owned by registrant. The Trademark Examining Attorney failed to make any mention of this application in that Office action, and this application later matured into

Registration No. 2862273. In her appeal brief, the Trademark Examining Attorney was trying to rebut the position of applicant that the term "Pacesetter" is a relatively weak mark because of the frequency with which it appears in third-party registrations, when she stated as follows:

Moreover, as to the matter of the strength of the term PACESETTER in the relevant marketplace, it bears noting that the registrant owns two other registrations with the same dominant element for similar goods, to wit: U.S. Registration No. 1483393 [sic 1483993] for the mark PACESETTER (Typed Mark) for "windows and doors made primarily of metal"; and U.S. Registration No. 2863373 [sic 2862273] for the mark PACESETTER WEATHERMASTER EXTERIOR WALL SYSTEM (Typed Mark) for "non-metallic exterior wall systems and coating systems comprised of polyvinyl chloride vinyl siding over contoured polystyrene." The examining attorney has attached these registrations and asks the Board to take judicial notice of the existence of the same.

Unfortunately for the Trademark Examining Attorney, inasmuch as the Board does not take judicial notice of applications and registrations residing in the records of the United States Patent and Trademark Office (USPTO), we deny the request of the Trademark Examining Attorney that we judicially notice the properties belatedly mentioned in her appeal brief.

Analysis: Likelihood of Confusion

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks

We turn first to the du Pont factor focusing on the similarity of the marks in their entirety. We must consider whether the marks are similar in sound, appearance, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

As to appearance, the Trademark Examining Attorney argues that the dominant element of registrant's mark, and hence, the portion to be accorded greatest weight in determining likelihood of confusion, is the term PACESETTER, inasmuch as it appears in a large, bold font.

Applicant, however, focuses on the large, stylized letter "P" and "the bulky word CORPORATION" to support its argument that when truly compared in their entireties, the marks are sufficiently different in appearance to avoid a likelihood of confusion.

As to sound, applicant argues that registrant's cited mark is phonetically distinguishable from applicant's mark since registrant's mark begins with the letter "P" and includes "the long and cumbersome word CORPORATION." On the other hand, the Trademark Examining Attorney contends that the term PACESETTER is the portion of the composite that consumers would use to call for registrant's goods and services.

As to meaning and commercial impression, applicant argues as follows:

As applied to Applicant's flooring, the word PACE clearly refers to "a manner of walking; tread." See Merriam-Webster's Collegiate Dictionary (10th Ed. 1997). Applicant's flooring is so comfortable, attractive and easy to maintain that it will enliven and invigorate the consumer's walk, providing him or her with a greater feeling of agility and happiness. This feeling of ease and agility is underscored by the clean, unadorned presentation of Applicant's Mark.

By contrast, in the Cited Marks, due to the use of the word CORPORATION, the emphasis is on the company providing the products, rather than the product itself. The company

is relying upon its reputation as a pace, or trendsetter, rather than touting the attributes of the particular products offered under the Mark. The difference is further emphasized by the bold and brassy impression of the Cited Marks, created by the emphatic use of the letter "P."

Applicant's brief, pp. 4 - 5.

The Trademark Examining Attorney argues that applicant, with this analysis, has improperly dissected registrant's mark, when it should be considered in its entirety. Furthermore, she argues that inasmuch as the average consumer is not likely to recall the slight differences between the marks, the focus of our analysis must be on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); TMEP §1207.01(b).

We agree with the Trademark Examining Attorney that these two marks are confusingly similar.

As to connotation and commercial impression, we are not convinced by applicant's tortured explanation that "[a]pplicant's flooring is so comfortable, attractive and easy to maintain that it will enliven and invigorate the consumer's walk, providing him or her with a greater feeling of agility and happiness" and that "[t]his feeling

of ease and agility is underscored by the clean, unadorned presentation of Applicant's Mark." Rather, we find that the term PACESETTER conveys the same connotation in applicant's mark as it does in the cited registrations.

Moreover, as to appearance, inasmuch as applicant's mark is presented in standard character form, it could well be presented in a specialized font identical to the term PACESETTER in the cited registration. While it is true that the registered mark has the letter "P," it serves to accentuate the first letter of the most prominent word, PACESETTER. We agree with the Trademark Examining Attorney that the words "THE" and "CORPORATION" are less significant given the smaller relative size of this lettering and that these words merely suggest something about the nature of registrant's entity without adding anything of distinctiveness.

As to the way potential consumers would call for the respective marks, it is clear that the identical term, PACESETTER, will necessarily be relied upon in both cases.

Finally, whether spoken or viewed, we find that both marks, in their entireties, create the same commercial impression.

Accordingly, we find that these marks are quite similar as to sound, appearance, connotation and commercial impression.

The number and nature of similar marks

As to the du Pont factor focusing on the number and nature of similar marks in use on similar goods, applicant argues

... that the scope of protection afforded marks containing the word PACESETTER should be relatively narrow, and that slight differences in the Marks should be enough to prevent likelihood of confusion. Reference is made to 22 other registered marks and one published mark which contain the PACESETTER element. These Registrations illustrate the narrow scope of protection afforded to the Cited Marks and the recognition given by the Trademark Office of the public's ability to distinguish among relatively close marks in this area, thus negating the likelihood of confusion.

Applicant's appeal brief, pp. 6 - 7. Applicant then proceeded to list the registrations⁴ and attached to its

⁴ (1) Registration No. 2532092 for the mark PACESETTER covering financial and investment services in the fields of securities, private equity financing, venture capital investment, and portfolio management;

(2) Registration No. 2425241 for the mark PACESETTER PLUS covering automobile and truck tires;

(3) Registration No. 1852339 for the mark PACESETTER covering commercial tumbler laundry dryers;

(4) Registration No. 2065344 for the mark PACESETTERS covering paper goods and printed matter, namely, newsletters advising of successful use of technologies in

the exploration, production, transportation, processing, distribution and end product use of natural gas excluding printed material relating to annual conferences of oil and gas industry representatives;

(5) Registration No. 1709178 for the mark PACESETTER covering electromechanical control apparatus and computer programs used in the operation of box manufacturing machines;

(6) Registration No. 2638896 for the mark PACESETTERS covering educational services, namely, conducting workshops, seminars and course of instruction for sharpening selling skills of real estate consultants;

(7) Registration No. 2588544 for the mark PACESETTERS INTERNATIONAL covering evangelistic and ministerial services;

(8) Registration No. 0621215 for the mark PACESETTER covering sewing machines and electric sewing machines for household and industrial uses, and parts of such sewing machines;

(9) Registration No. 2266046 for the mark PACESETTER covering generator for golf carts and electronic braking mechanism; [since cancelled under Section 8]

(10) Registration No. 2149708 for the mark PACESETTER covering hair care preparations, namely, shampoos, conditioners and styling gels, deodorant, antiperspirant, hand and body soaps, bubble bath, body wash, shower and bath gel, nail polish remover, petroleum jelly for cosmetic purposes, shower and bath powder, hand and body cream, cold cream, hand and body lotion, hand and body oil, analgesic and vaporizing balms;

(11) Registration No. 1868181 for the mark PACESETTER covering inflatable boats and boat accessories; namely, rope sold together with inflatable boats; air pumps for inflatable boats; boat repair kits consisting of vinyl sheets, vinyl cement and blister cards for repair of inflatable boats; and boat patch kits consisting of adhesive vinyl patches and blister cards for repair of inflatable boats; paddles and oars;

(12) Registration No. 2344511 for the mark PACESETTER covering promoting the goods and services of others by affixing client's logos to merchandise and providing business management assistance with regard to the distribution of the merchandise to end users;

brief copies of the registrations taken from the electronic records of the USPTO.

In response, the Trademark Examining Attorney argues that

... none of the noted registered marks apply to the types of goods or services the applicant and the registrant have identified. Therefore, the scope of

(13) Registration No. 1098038 for the mark PACESETTER covering medical instruments-namely, devices implantable in a living body and related instruments;

(14) Registration No. 2577506 for the mark THE INDUSTRY PACESETTER covering services relating to satellite communications and microwave networking systems/services, namely digital and analog transmission of audio, visual, and data signals via satellite;

(15) Registration No. 1595228 for the mark PACESETTER IV covering tires;

(16) Registration No. 2296376 for the mark PACESETTER STEEL SERVICE & Design coveting hot rolled steel, cold rolled steel, and coated rolled steel;

(17) Registration No. 1315261 for the mark PACESETTER for offset printing inks; [since cancelled under Section 8]

(18) Registration No. 1433592 for the mark PACESETTER SOFTWARE covering computer programs recorded on magnetic disc for use in the field of business management;

(19) Registration No. 2747163 for the mark NORDSTROM PACESETTER covering credit card services;

(20) Registration No. 2031195 for the mark PACESETTER covering temporary help services, namely furnishing of employees on a contract basis to persons or places of business requiring part-time or temporary help, including skilled and unskilled industrial and construction workers;

(21) Registration No. 0992060 for the mark PACESETTER covering wiping towels;

(22) Registration No. 1248850 for the mark PACESETTER covering Electrical wet cell storage batteries; and

(23) Registration No. 2755986 for the mark PACESETTER covering award programs for honoring professionals in the custom building business.

protection sought herein is sufficiently narrow in that only applications identifying related goods, such as the applicant's, would be estopped from registration.

Trademark Examining Attorney's brief, p. 8.

Although these copies of third-party registrations were not timely submitted, the Trademark Examining Attorney did not object to them as untimely under TM Rule 2.142(d). Instead, she has treated them as if they had been made part of record in a timely manner, so we too will consider them.

To the extent the third-party registrations are for related goods, they may well indicate, as would dictionary entries, that the involved term(s) makes the composite term suggestive. However, on the merits of this showing, we have to agree with the Trademark Examining Attorney that " ... none of the noted registered marks apply to the types of goods or services the applicant and the registrant have identified."⁵

Accordingly, we find that registrant's mark is not so weak in the area of home improvement products that it should be limited only to a very narrow scope of

⁵ We also cannot help but notice that applicant's long listing did not include any of the PACESETTER registrations where the mark is indeed used in connection with home improvement products - all of which are owned by registrant: Reg. Nos. 1136007, 1146284, 1483993, 1491510 and 2862273.

protection, and thus this factor too favors the position taken by the Trademark Examining Attorney.

Relationship of the Goods:

We turn then to the du Pont factor focusing on the relationship of the goods and/or services as described in the application and registration.

In support of its position that the goods are not related, applicant cites to In re American Olean Tile Company Inc., 1 USPQ2d 1823 (TTAB 1986). However, while that case clearly states that there is no *per se* rule that all building construction goods are related, the case also notes that "*no evidence* was introduced during prosecution of the case" (*Id.* at 1824, *emphasis* supplied) and that applicant's specimens of record demonstrated that ceramic tiles would likely be purchased and installed by sophisticated purchasers, who would be most familiar with the separate manufacturing sources of those different products. *Id.* at 1825 - 26.

The Trademark Examining Attorney has introduced into the record six use-based third-party registrations (two of which are owned by the same entity) showing entities that have used the same product mark on windows, doors and

flooring, or as a service mark for the manufacture, repair and maintenance of the same:⁶

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for *inter alia* "building materials, namely, ... non-metal windows, non-metal doors, ... parquet wood strips, parquet wood floors, wood flooring, gymnasium wood flooring, laminate wood flooring, ..." in International Class 19; and linoleum; linoleum and vinyl floors; floor coverings of cork, rubber, plastics, or substitutes therefor; gymnasium flooring of cork, rubber, plastics or substitutes therefor; laminate flooring of cork, rubber, plastics or substitutes therefor; insulating vinyl floor coverings ..." in International Class 27;⁷



For "repair and maintenance of rolling metal doors, glass doors, windows, ... flooring ..." in International Class 37;⁸

⁶ The Trademark Examining Attorney also included in the record six additional third-party registrations based on Section 44(e) of the Act, which of course, have absolutely no probative value as to trade channels in the United States: specifically, these included Registration Nos. 2136493, 2501276, 2495400, 2577195, 2706322 and 2706329.

⁷ Registration No. 2322050 issued to Hamberger Industrierwerke GmbH, a German corporation, on February 22, 2000 claiming first use anywhere and first use in commerce on the goods in International Class 19 at least as early as May 1998, first use anywhere and first use in commerce on the goods in International Class 27 at least as early as January 1996. Section 8 affidavit accepted (six-year) and Section 15 affidavit acknowledged.

⁸ Registration No. 2714912 issued Metro Door, Inc. on May 13, 2003 claiming first use anywhere and first use in commerce at least as early as May 31, 2000. The words "USA FACILITIES MAINTENANCE" and "DOOR INC." were disclaimed apart from the mark as shown.



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For " ... wood tile floors, not of metal; ... concrete building elements, namely beams, blocks; tiles for building, namely, non-metal roofing tiles, tiles of gypsum for wall, floor and ceiling; ... prefabricated non-metal buildings; building glass for windows and doors, not of metal; doors, not of metal; windows, not of metal..." in International Class 19;⁹

for *inter alia* "residential and commercial flooring, namely, wood tiles, ceramic tile, and natural stone tile; architectural hardware namely, wood doors and frames; window glass and glass and plastic glazing for interior and exterior windows; drywall for interior walls and partitions, drywall soffits and ceilings; wood laminate flooring" in International Class 19;¹⁰



For *inter alia* "residential and commercial flooring, namely, wood tiles, ceramic tile, and natural stone tile; architectural hardware namely, wood doors and frames; window glass and glass and plastic glazing for interior and exterior windows; drywall for interior walls and partitions, drywall soffits and ceilings; wood laminate flooring" in International Class 19;¹¹ and

⁹ Registration No. 2587370 issued to Beijing New Building Materials Co., Ltd. on July 2, 2002 claiming first use anywhere at least as early as May 11, 1983 and first use in commerce at least as early as June 15, 1999.

¹⁰ Registration No. 2687956 issued to H.J. Martin and Son, Inc. on February 18, 2003 claiming first use anywhere at least as early as 1931 and first use in commerce at least as early as 1978.

¹¹ Registration No. 2687959 also issued H.J. Martin and Son, Inc. on February 18, 2003 claiming first use anywhere at least as

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For "custom manufacture of roof trusses, wall panels for new construction, floor trusses, doors and windows" in International Class 40.¹²

These third-party registrations, which are based on use in commerce, and which individually cover a number of different goods and services, provide some support for the Trademark Examining Attorney's position that windows and doors as well as flooring materials are related because they show that these goods and involved services have been registered by the same source under the same mark. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) [Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"]. See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

While applicant's goods clearly do not overlap with registrant's goods and services, we conclude from these third-party registrations that throughout their product

early as 1931 and first use in commerce at least as early as 1978.

¹² Registration No. 2720028 issued Carolina Holdings, Inc. on May 27, 2003 claiming first use anywhere and first use in commerce at least as early as December 2000.

lives (e.g., manufacture, sale, maintenance and repair), windows, doors and flooring materials are handled by the same entities, using the same trademarks and service marks.

Accordingly, given this relationship of applicant's goods to registrant's goods and services, this du Pont factor too favors the position taken by the Trademark Examining Attorney.

Channels of trade

We turn then to the similarity or dissimilarity of established, likely-to-continue trade channels. Although the Trademark Examining Attorney failed to place into the record any evidence to show that these respective goods would be sold in the same section of home improvement stores, or that they would be advertised or sold side-by-side, it is clear to us from the very nature of the respective goods that they would be found for sale at the same home improvement stores and building supply outlets, and that they would be available at such retail centers to the ordinary "do-it-yourself" consumers."

Conclusions

In conclusion, the record is sufficient to support the conclusion that there is a likelihood of confusion

herein, namely, that applicant's mark is quite similar to registrant's cited mark, that PACESETTER is not a weak mark in the area of home improvement products, that applicant's goods are deemed to be related to registrant's goods and services, and that they would flow through the same channels of trade to the same group of ordinary consumers.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby affirmed.